

Application No.: 10/751,125  
Amendment Dated: October 29, 2004  
Reply to Office Action of: 10/04/04

### REMARKS/ARGUMENTS

Claims 1-5, 8, 10-13, 15 and 16 stand rejected under 35 U.S.C. 102(b) as being anticipated by Wilhelmy (U.S. Patent No. 5,722,977). Applicants have canceled claim 13, without prejudice, amended claims 1 and 5 to more distinctly define aspects of the invention, and respectfully traverse the rejection as applied to Claims 1-5, 8, 10-12 and 15 as follows.

Claims 1-5, 8, 10-12 and 15 and recite, inter alia, an osteotome whose head includes first and second planar surfaces where the second planar surface extends at an obtuse angle relative to the first planar surface. The term "obtuse angle" is defined in accordance with accepted mathematical usage and refers to an angle greater than 90 degrees and less than 180 degrees. See Webster's II New College Dictionary.

Wilhelmy discloses an osteotome having a rectangular or quadrilateral cutter head 36. A device according to Wilhelmy cannot define an obtuse angle between two adjacent cutting sides. Moreover, Wilhelmy's disclosure teaches away from an osteotome having less than four sides since such an osteotome would not be capable of performing the essential purpose of removing a precisely shaped piece of spinal bone.

For at least these reasons, Applicants respectfully request that the rejection of claims 1-5, 8, 10-12 and 15 be reconsidered and withdrawn.

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Claims 6, 7 and 14 stand rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelmy in view of Urbahns (U.S. 6,265,657). Applicants have amended claim 6 to more distinctly define aspects of the invention.

As a preliminary matter, Applicants respectfully repeat herein the reasons provided above in traversing the rejection in view of Wilhelmy alone.

Applicants respectfully assert that it is improper to combine the teachings of these two references for two reasons. First, the modification proposed by the Examiner directly contravenes the essential purpose of Wilhelmy of removing a bone plug. Wilhelmy teaches that all four cutting surfaces are razor sharp to minimize the required impact force. See col. 7 lines 10-15. The addition of a superfluous (in the context of Wilhelmy) protuberance to the cutting blade would render the device unfit for its intended use. As such there can be no motivation to combine. Second, in order to combine the teachings of one reference with another there must be at least a threshold showing of a suggestion to combine. There is no such threshold showing here.

For at least these reasons, Applicants respectfully request that the rejection of claims 6, 7 and 14 be reconsidered and withdrawn.

Claim 9 stands rejected under 35 U.S.C. 103(a) as being unpatentable over Wilhelmy.

Wilhelmy discloses an osteotome having a rectangular or quadrilateral cutter head 36. Wilhelmy's disclosure explicitly teaches away from an osteotome having less than four sides since such an osteotome would not be capable of performing the essential purpose of removing a precisely shaped piece of spinal bone. A device according to Wilhelmy having a rectangular or quadrilateral

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cutter head 36 cannot define an obtuse angle of about 135 degrees between any two adjacent cutting sides.

Claim 9 recites that the second planar surface extends at an angle of about 135 degrees relative to the first planar surface, and that the third planar surface at an angle of about 135 degrees relative to the second planar surface.

For at least these reasons, Applicants respectfully request that the rejection of claim 9 be reconsidered and withdrawn.

It is believed that the above Remarks represent a complete response to the Office Action and that the Application is now in condition for allowance, and such favorable determination is requested.

Applicant respectfully requests that a timely Notice of Allowance be issued in this case.

It is believed that the above Remarks represent a complete response to the Office Action and that the Application is now in condition for allowance, and such favorable determination is requested.


In the event Applicants have overlooked the need for an extension of time or payment of fee, Applicants hereby petition therefore and authorizes that any charges be made to Deposit Account No. 50-2779, ZIMMER TECHNOLOGY, INC.

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If any questions regarding this Application should arise, the Examiner is encouraged to contact the undersigned.

Respectfully submitted,

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